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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,382	02/08/2001	Adrian P. Wise	94100422(EP)USCIXICID11 P	7169
22887	7590	08/16/2004	EXAMINER NGUYEN, DUSTIN	
DISCOVISION ASSOCIATES INTELLECTUAL PROPERTY DEVELOPMENT 2355 MAIN STREET, SUITE 200 IRVINE, CA 92614			ART UNIT 2154	PAPER NUMBER

DATE MAILED: 08/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center">Office Action Summary</p>	<p>Application No.</p> <p>09/779,382</p>	<p>Applicant(s)</p> <p>WISE ET AL.</p>	
	<p>Examiner</p> <p>Dustin Nguyen</p>	<p>Art Unit</p> <p>2154</p>	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>02/08/2001</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 – 17 are presented for examination.

Specification

2. Examiner requests Applicants to update the status of any related applications as mentioned in the specification [i.e. page 1, paragraph 1].
3. The abstract of the disclosure is objected to because the abstract is the same for other copending applications and also missing period at the end of the abstract. Correction is required. See MPEP § 608.01(b).
4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Information Disclosure Statement

5. Examiner requests Applicants to resubmit Foreign Patent or Published Foreign Patent Application and Other Documents as mentioned in the IDS filed on 02/08/2001 to be considered.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of patent No. 6038380 [hereinafter '380 patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the following reasons:

As per claims 1-17 of instant application, the '380 patent contains the subject matter claimed in the instant application. As per claim 1, both are claiming common subject matter as follows:

A decoder interface comprising:

an input circuit ...; and

control circuit

The claims of '380 patent does not specifically state receive raw byte data and tokens as described in the claims 1-17 of instant application but it would have been obvious to a person

Art Unit: 2154

skill in the art to recognize that the two claims are similar because token generator of claims 1-7 in '380 patent perform the same functions of generating tokens from a stream of input data.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 5, 6, 13, 14, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following terms lack antecedent basis:

I. the first - claim 5, line 2

II. the first - claim 13, line 1.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whiting et al. [US Patent No 5,016,009], in view of Horvath et al. [US Patent No 5,450,599].

12. As per claim 1, Whiting discloses the invention substantially as claimed including a decoder interface comprising:

an input circuit that has a port for receiving encoded data [232, Figure 7]; and
control circuitry that is coupled to and controls the input circuit [230, Figure 7] to operate selectively in a first mode [233, Figure 7; and col 18, lines 50-col 19, lines 10] to receive raw byte data at the port [i.e. data character stream] [Abstract; and col 18, lines 34-36] and a second mode [235, Figure 7; and col 19, lines 11-15].

Whiting does not specifically disclose the second mode to receive token at the port.

Horvath discloses the second mode to receive token at the port [i.e. block] [col 1, lines 37-41; and col 9, lines 32-38].

It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Whiting and Horvath because Horvath's teaching of token would allow information to be recognized correctly so that processing information can be performed in a more efficient manner.

13. As per claim 2, Whiting discloses wherein the port comprises a coded data port [col 20, lines 42-50].

14. As per claim 3, Whiting discloses a microprocessor interface [5, Figure 1a; and col 8, lines 22-25].

15. As per claim 4, it is rejected for similar reasons as stated above in claim 3.

16. As per claim 5, Whiting discloses the control circuitry includes a byte code signal for selecting the first or second mode [col 18, lines 35-49].

17. As per claim 6, Whiting discloses the mode selection is dynamically changeable [col 2, lines 64-col 3, lines 13].

18. As per claim 7, Whiting does not specifically disclose the received raw byte data is placed into tokens. Horvath discloses the received raw byte data is placed into tokens [col 8, lines 3-24]. It would have been obvious to a person skill in the art at the time the invention was made to combine the teaching of Whiting and Horvath because Horvath's teaching would allow to reduce processing overhead to increase system performance.

19. As per claim 8, Horvath discloses the first byte of the raw byte data causes a token header to be generated [Figure 2; and col 4, lines 15-30].

20. As per claim 9, Horvath discloses subsequent bytes of the raw byte data appended to the token header to form tokens [Figure 2; and col 4, lines 42-58].

21. As per claims 10-17, they are method claimed of claims 1-9, they are rejected for similar reasons as stated above in claims 1-9.

Art Unit: 2154

22. A shortened statutory period for response to this action is set to expire **3 (three) months and 0 (zero) days** from the mail date of this letter. Failure to respond within the period for response will result in **ABANDONMENT** of the application (see 35 U.S.C 133, M.P.E.P 710.02, 710.02(b)).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dustin Nguyen whose telephone number is (703) 305-5321. The examiner can normally be reached on Monday – Friday (8:00 – 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directly to the receptionist whose telephone number is (703) 305-3900.

Dustin Nguyen


JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100